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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,755	07/26/2001	James W. Barmettler	10004604-1	9081

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EXAMINER	
QUELER, ADAM M	

ART UNIT	PAPER NUMBER
2179	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/916,755	BARMETTLER, JAMES W.	
	Examiner	Art Unit	
	Adam M Queler	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 March 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) *9-16 and 25-32* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8 and 17-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/12/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Application filed 07/26/2001, and IDS filed 03/12/2003.

2. Claims 1-32 are pending in the case. Claims 1, 9, 17, and 25 are independent claims. Claims 9-16 and 25-32 withdrawn from further consideration

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8 and 17-24, drawn to extracting a selected portion, classified in class 707, subclass 3.

II. Claims 9-16 and 25-32, drawn to an interface for print selection, classified in class 345, subclass 856.

The inventions are distinct, each from the other because of the following reasons:

4. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the picture and attribute are not necessary. The subcombination has separate utility such as marking a page.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Jeff Limon a provisional election was made without traverse to prosecute the invention of Group I, claims 1-8 and 17-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-16 and 25-32 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-8, and 20-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4, 8, 20, and 23 recite the trademarks "ActiveX®" and "JavaScript®." If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. See *Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982)*. The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product

would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

Claims 4-8 and 20-24 all recite negative limitations that render the claims indefinite because it attempts to claim the invention by excluding what the Applicant did not invent rather than distinctly and particularly pointing out what was. See *In re Schechter, 205 F.2d 185, 98 USPQ 144 (CCPA 1953).*

Claim 1 recites "passing a named tag element for the desired portion into the desired portion of the web page." There appears to be a slight wording error somewhere in the claim. The Office notes that language which appears to be the intended meaning (surrounding the desired portion with a named tag element), appears in claim 17 and is acceptable. Claims 2-8 are rejected for incorporating the same deficiency.

Claim 4 recites the limitation "the scripting language" in line 1. There is insufficient antecedent basis for this limitation in the claim. For examining purposes only it will be assumed that the claim is meant to depend on claim 3.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. **Claims 1-3, 5-8, 17-19, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima (US 20030035144A1, filed 5/18/2001).**

Regarding independent claim(s) 1, Shima teaches a named tag element for the desired portion around the desired portion of the web page (para. 45, ll. 8-9). Shima teaches querying the named tag portion and extracting the text (para. 13, ll. 6-7). Shima teaches extracting to a new document (para. 13, ll. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to open this document, thereby opening a browser window and sending the text there, because an HTML document is well-known in the art to be viewed in a browser. Shima teaches printing (para. 15, ll. 7-9).

Regarding independent claim(s) 17, Shima teaches a mechanism for invoking a script that calls a print function (para. 46, ll. 5-7). Shima teaches a named tag element for the desired portion around the desired portion of the web page (para. 45, ll. 8-9). Shima teaches querying the named tag portion and extracting the text (para. 13, ll. 6-7). Shima teaches extracting to a new document (para. 13, ll. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to open this document, thereby opening a browser window and sending the text there, because an HTML document is well-known in the art to be viewed in a browser. Shima teaches printing (para. 15, ll. 7-9).

Regarding dependent claim(s) 2 and 18, Shima teaches a script (para. 46, ll. 5-7).

Regarding dependent claim(s) 3 and 19, Shima does not teach using a scripting language. SSJ teaches using a scripting language (p.2, para 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Shima and SSJ to use JavaScript to open the window, in order to offload processing to the client (Table 4.1).

Regarding dependent claim(s) 5 and 21, Shima does not teach additional downloading.

Regarding dependent claim(s) 6 and 22, Shima does not teach a plug-in.

Regarding dependent claim(s) 7 and 23, Shima does not teach an executable.

Regarding dependent claim(s) 8 and 24, Shima does not teach an ActiveX® control.

12. Claims 4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima as applied to claims 3 and 19 above, and further in view of "Basics of Server-Side JavaScript, Chapter 4", (published 10/30/97), hereinafter SSJ.

Regarding dependent claim(s) 4 and 20, Shima does not teach using a JavaScript. SSJ teaches using JavaScript® (p.1, para 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Shima and SSJ to use JavaScript to open the window, in order to offload processing to the client (Table 4.1).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ

STEPHEN S. HONG
PRIMARY EXAMINER